

REMARKS

New claims 268, 351, 354, 356, and 360 have been submitted to more distinctly claim the present invention. Dependent claims 169-261 have been resubmitted as new
5 claims 269-350, 352-353, 355, 357-359, and 361-362. Some of these new claims are slightly amended as detailed above. Claims 262, 264-265, and 267 have been amended and claims 263 and 266 remain as previously submitted. Applicants believe that the following comments overcome the rejections
10 set forth in the December 4, 2002 Office Action and that the rejections should be withdrawn.

I. THE INVENTION

Generally, the present invention is a system for
15 accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed catalog having at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code,
20 magnetic code, printed character, invisible icon, etc. In the present invention, these machine recognizable features are scanned or sensed and converted into an electronic signal, which is transmitted to be processed. The processing results in the display of programming material

related to the information contained in the printed catalog. Importantly, the present invention is designed to allow a user to access programming material related to the information contained in the catalog to supplement the
5 information provided by the printed catalog.

II. THE EXAMINER'S REJECTIONS

A. 35 U.S.C. § 102(b)

The Examiner rejected claims 168, 262, and 265 under
10 35 U.S.C. § 102(b) as being anticipated by Mondschein U.S. Patent No. 4,418,278 (hereinafter referred to as "Mondschein"). Initially, the Examiner summarizes various embodiments of Mondschein. The Examiner focuses primarily on an embodiment that includes a page having pinhole-size
15 perforations on its surface that allow light to penetrate through the page. A user may write on the page with a pencil, which causes the perforations to become occluded with pencil lead. Light detecting sensors located at the opposite end of the optical fibers detect the occluded
20 perforations, whereafter, information regarding the status of each perforation is transmitted to a decoding unit representing one bit of information. The decoding unit then displays the decoded information to the user via a

display unit. Specifically, the Examiner opines that catalog sheet 92, indicated in FIG. 7A of Mondshein:

"may be provided with a series of entry ports 94 adjacent [to] written material generally indicated at 96. Moreover, a part number, price quantity matrix 98 may be provided [sic] at the bottom of a catalog sheet, with entry ports as illustrated ... Thus, the marking of the catalog sheet by a pencil 100 provides all of the necessary information, such that when the catalog is connected by a fiber optic cable 102 to a decoding unit 104, the information encoded in the catalog sheet may be read out and displayed at 106 or provided to a modem 108 for direct transmission to a manufacturer." (December 4, 2002 Office Action Summary, pp. 3-4).

The Examiner asserts that "Mondshein discloses a printed catalog comprising [a] machine recognizable feature that can be read, decoded, and displayed to a user." (December 4, 2002 Office Action Summary, p. 5).

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 169-261, 263-264, 266, and 267 under 35 U.S.C. § 103(a) as being unpatentable over Mondshein "in view of the general teachings of the prior

art of record" (December 4, 2002 Office Action Summary, p. 5). Regarding claims 170-261, 263-264, 266, and 267, the Examiner notes that these claims differ by claiming different types of machine recognizable features, different types of networks, and additional features such as "menu, listings, the method of payments and shipments." (December 4, 2002 Office Action Summary, p. 5). The Examiner contends that all of these elements would have been an obvious addition to the system disclosed in Mondshein. Also, the Examiner states that using a data link to transmit video, image, and shopping data would be design considerations within the "skill levels and expectations of an ordinary skilled artisan." (December 4, 2002 Office Action Summary, p. 5). The Examiner further states that interchanging various "data input sources" and various networks with those disclosed in Mondshein would be a design consideration that was not novel. Additionally, the Examiner opines that it is obvious to add methods of providing payment, shipping, and return information to the system disclosed in Mondshein because these methods are "known and old and have been made commercially available." (December 4, 2002 Office Action Summary, p. 6).

To support the aforementioned conclusions, the Examiner cites Veeneman et al. U.S. Patent No. 5,774,874

(hereinafter referred to as "Veeneman"); Montanari et al. U.S. Patent No. 5,478,990 (hereinafter referred to as "Montanari"); and Sangster U.S. Patent No. 4,609,358 (hereinafter referred to as "Sangster").

5 Regarding Veeneman, the Examiner states that a system that includes a bar code scanner is disclosed such that the bar code scanner:

10 "could be located in a registrant's home such that the registrant could register for items from multiple merchants via a catalogue that includes bar codes for the items. The registrant would communicate to the kiosk via remote communication, such as a modem or the InterNet. The term catalog should be understood to be not
15 limited to a physical paper catalog, but also encompasses things such as CD-ROMs, and other data storage devices." (December 4, 2002 Office Action Summary, p. 6).

20 With respect to Montanari, the Examiner points to a method for tracking the production history of a particular food product. Specifically, tags encoded with tracking numbers are used to track an animal's meat product throughout the growing and production process.

"As ownership and possession of an animal is transferred, the Animal Tracking Number (A-TN) is recorded on a tag, preferably in an electronic or computer readable form, such as a bar-code or magnetic strip, and vital information ... may be added to the database record via such tag at various times in a growth of the animal, as well as in the fabrication process." (December 4, 2002 Office Action Summary, p. 7).

Regarding Sangster, the Examiner notes that the disclosure provides student stations comprising microcomputers whereon responses to situations presented on a television or videodisc player may be entered. Further, student responses cause the appropriate output to be sent to the television monitors or cause the videodisc player to access the appropriate portion of the videodisc.

C. DOUBLE PATENTING

The Examiner rejected claims 168, 262, and 265 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter referred to as "the '863 patent"). "Although the conflicting claims are not identical, they are not patentably distinct from each other

because they all recited [sic] the same limitations"
(December 4, 2002 Office Action Summary, p. 9).

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

5 A. 35 U.S.C. § 102(b)

 The Examiner rejected claims 168, 262, and 265 under
35 U.S.C. § 102(b) as being anticipated by Mondshein.
Claim 168 has been cancelled, and five new independent
claims are presented for review. Applicants submit that
10 claims 262 and 265 as originally written and as amended are
not anticipated by Mondshein. Applicants submit that
claims 262 and 265 are amended herein purely to more
clearly define the scope of the invention and not for any
reasons related to patentability.

15 With respect to claim 168, Applicants have cancelled
this claim and present herein five new renditions of claim
168, namely claims 268, 351, 354, 356, and 360. Each of
these newly added claims more clearly defines the machine
recognizable feature as a printed machine recognizable
20 feature, a bar code, a magnetic code, a watermark, and an
invisible machine recognizable feature, respectively.
Mondshein does not disclose the use of any of these types
of machine recognizable features. In contrast, Mondshein
discloses a system wherein a machine recognizes the absence

or presence of light through pinhole size perforations printed on a page. In other words, if Mondshein does disclose a "machine recognizable feature", such a feature is the absence or presence of light through page perforations. Mondshein does not disclose a system wherein a machine reads a printed machine recognizable feature, a bar code, a magnetic code, a watermark, or an invisible machine recognizable feature of a printed medium and accesses supplemental information related to the printed medium. Thus, Mondshein cannot anticipate newly added independent claims 268, 351, 354, 356, and 360.

With respect to claims 262 and 265, Mondshein does not anticipate either claim. These claims now include the step of "printing a machine recognizable feature within a printed catalog." (emphasis added). Again, Mondshein discloses a system wherein a machine reads the absence or presence of light through page perforations. Such a feature cannot be printed in a printed catalog. Furthermore, no other features are disclosed in Mondshein that are able to be read by a machine and are capable of being printed in a printed catalog, and therefore, Mondshein cannot anticipate either of claims 262 and 265.

Consequently, Mondshein fails to disclose any of the claimed machine recognizable features of newly added claims

268, 351, 354, 356, and 360 or the step of printing a machine recognizable feature as claimed in claims 262 and 265. Therefore, Applicants submit that claims 262, 265, 268, 351, 354, 356, and 360 are not anticipated by Mondshein and are in condition for allowance.

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 169-261, 263-264, 266, and 267 under 35 U.S.C. § 103(a) as being unpatentable over Mondshein "in view of the general teachings of the prior art of record." (December 4, 2002 Office Action Summary, p. 5). Claims 169-261 have been resubmitted as claims 269-350, 352-353, 355, 357-359, and 361-362, and some claims have been slightly amended. Claims 263 and 266 are still pending and have been slightly amended to correct typographical errors. Claims 264 and 267 remain pending as originally submitted.

Applicants respectfully submit that none of the aforementioned claims are obvious in view of Mondshein and the general teachings of the prior art. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art

references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

5 Initially, Applicants submit that no suggestion or motivation to modify Mondshein or combine it with any of the teachings of the prior art of record exists.

10 Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of
15 references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

20 The Examiner contends that it would be obvious to combine the teachings of Mondshein with Veeneman, Montanari, and Sangster to arrive at the various embodiments of Applicants' invention. Applicants submit
25 that none of these combinations would have been obvious to one skilled in the art at the time of Applicants' invention.

 First, no suggestion or motivation exists for adding the bar code scanning capabilities disclosed in Veeneman to
30 Mondshein. Mondshein provides a page containing embedded

fiber optics that sense the status of page perforations (i.e., occluded or penetrated by light) to detect the presence of handwritten lead or a location on a page. In stark contrast, bar code systems cannot be used to detect writing or a location on a page. A bar code scanner is used solely to decode the information contained within a bar code, and such information is not changed when a user writes on or otherwise chooses a location on the page on which the bar code is printed. Whereas a motivation may exist to combine other methods of sensing writing or a location on a page with Mondschein, bar code systems cannot provide that function, and therefore, there is no motivation or suggestion to combine Veeneman or any other bar code system with Mondschein.

Similarly, no suggestion or motivation exists for combining the tracking system disclosed in Montanari with the system disclosed in Mondschein. Montanari provides a tracking system for tracking the production history of a food product using tags containing encoded tracking numbers. The system disclosed in Montanari cannot be used to detect writing or a location on a page. Rather, a scanner is used solely to decode an encoded tracking number contained on a tag. This tracking system simply identifies the status of a material item. The information, or

tracking tag number, retrieved from the tag upon scanning does not change when a user writes on or otherwise chooses a location on the tag. Again, whereas a motivation may exist to combine other methods of sensing writing or a
5 location on a page with Mondschein, the system disclosed in Montanari cannot provide that function, and therefore, there is no motivation or suggestion to combine Montanari with Mondschein.

Furthermore, no suggestion or motivation exists for
10 combining the Sangster and Mondschein references. Sangster discloses a video training system for simultaneously training multiple students who respond to training prompts by entering responses on the respective student station's microcomputer. Sangster intends to allow students to
15 interact with a training program via a computer terminal having traditional keyboard and mouse inputs. By adding the fiber optics system of Mondschein which detects handwriting or location of a pen, the overall system would only be unnecessarily confused because means for input already
20 exist. Moreover, the Mondschein lacks the versatility of input of a traditional keyboard and mouse and thus provides a disincentive for combination with Sangster. Consequently, there is no motivation or suggestion to combine Montanari with Mondschein.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" conclusion. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the goals of the present invention.

In addition to the lack of suggestion or motivation to combine any of the aforementioned references, there is no expectation of success for any of the aforementioned combinations. Mondshein provides a page containing
5 embedded fiber optics that sense the status of page perforations (i.e., occluded or penetrated by light) to detect the presence of handwritten lead or a location chosen by the user of the page. In contrast, a bar code scanning system of Veeneman detects the predefined physical
10 characteristics of the bar codes, including the quantity of printed bars and each bar's width and distance from adjacent bars. The embedded fiber optics disclosed in Mondshein cannot sense the bar code disclosed in Veeneman and the bar code scanner of Veeneman cannot sense the
15 status of occluded perforations or locations on a page. Thus, the sensed objects and the sensing devices of these two references cannot be successfully interchanged. Consequently, there is no reasonable expectation of success in combining the Mondshein and Veeneman references.

20 For similar reasons, there is no reasonable expectation of success when combining the Mondshein and Montanari references. The embedded fiber optics disclosed in Mondshein cannot sense the encoded tracking number disclosed in Montanari, and the scanning system disclosed

in Montanari cannot sense the status of occluded perforations or locations on a page. Thus, the sensed objects and the sensing devices of these two references cannot be successfully interchanged. Therefore, there is
5 no reasonable expectation of success in combining the Mondshein and Montanari references.

Finally, the microcomputer input of Sangster cannot be successfully integrated into the system disclosed in Mondshein. In essence, the entire goal in Mondshein is to
10 provide a system that accepts *handwritten* input in order to choose corresponding information for display to the user. Likewise, Sangster discloses a system that accepts traditional microcomputer input (i.e., keyboard, mouse, keypad, etc.) in order to choose corresponding information
15 for display to the user. In order to combine these references, the device of Mondshein must somehow be able to provide input to the videodisc player of Sangster. This, however, is not an easy or obvious process. One must create specialized hardware and/or software to allow these
20 devices to communicate, which would require a significant inventive step. Thus, there is no reasonable expectation of success in combining the Mondshein and Sangster references.

Consequently, Applicants submit that claims 269-350,
352-353, 355, 357-359, and 361-362 of the present invention
are not obvious in view of the cited references because
there is no suggestion or motivation to combine the
5 references and any attempted combination of these
references does not have a reasonable expectation of
success.

C. DOUBLE PATENTING

The Examiner rejected claims 168, 262, and 265 under
10 the judicially created doctrine of obviousness-type double
patenting as being unpatentable over claim 1 of the '863
patent. In response, Applicants are filing a Terminal
Disclaimer herewith to overcome the Examiner's double
patenting rejection.

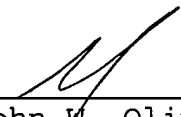
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CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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